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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,869	08/02/2000	Raymond J Sabbagh	D/A0105	8927

7590 03/18/2002

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EXAMINER

NOLAN JR, CHARLES H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/631,869

Applicant(s)

SABBAGH ET AL.

Examiner

Charles H Nolan

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner, ONLY.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claims 15-22 are objected to because of the following informalities: Independent Claim 15 recites "a printer to output convert electronic signals...." Perhaps, Applicant meant to recite -- a printer to output converted electronic signals --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6, 8, 18 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6,8,18 and 21 recite Windows Operating System, Windows NT and Microsoft in the claims to further limit the parent claims. Trademark usage in claims to limit the claims or to describe a product are not in compliance with 35 U.S.C. 112, second paragraph. Applicant's attention is invited to MPEP section 2173.05(u) for further guidance about the usage of trademarks in claims. A trademark is used to describe a family of products. Even Applicant's recitation of Windows NT is not distinct because other Windows operating systems follow the NT platform. Therefore, Applicant has failed to particularly point and distinctly claim the method and/or system to output

printed documents. Second, the Examiner wonders why Applicant would want to limit the use of his method/apparatus to the Microsoft family of software?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1,2,3,7,8,9,10,11, 13,14,15,16,17,18,19,21,22 are rejected under 35 U.S.C. 102(b) as being anticipated by Gase et al (5,580,177, hereinafter "Gase").

With respect to Claim 1, Gase teaches the monitoring step in figure 3a, element 74, the recognizing step in figure 3a, element 76 and the saving step in the Abstract, lines 4-6 or column 4, lines 12-20. The Examiner notes that the gathering step is an inherent part of Gase. Printer configuration information is typically "gathered" directly from the printer, via "Plug and Play" as implied by Gase in column 5, lines 8-12. Therefore, the

Examiner's position is that the Gase reference as a whole anticipates Claim 1. With respect to Claims 7 and 13, note the rejection of Claim 1 above and the printer port of a print server 28' on the front page diagram. With respect to Claim 15, Gase teaches the printer 18, the first client device 14 with local print registry 28, second client device 12 and the printer server 44 on the front page diagram. With respect to Claim 2, Gase teaches the waking and alerting steps in figure 3a, elements 74-76. With respect to Claim 3, the Examiner has interpreted the term "thread" as recited in this claim to mean -- part --. Accordingly, Gase teaches the printer manager thread in column 6, lines 8-15. With respect to Claims 8 and 21, Gase teaches that his invention may be used with Windows software in column 6, lines 53-54. It is noted the teaching of a genus anticipates the use of any of the species known at the time the instant invention was filed. The Examiner argues by analogy to chemical formulas. A generic chemical formula anticipates a claimed species covered by the formula if it can be at once envisaged from the generic formula. It is noted that as the Examiner typed the instant rejection on this Windows NT computer that the teaching of Windows software by Gase "at once envisaged" Windows NT. Applicant's attention is invited to MPEP section 2131.02 for further discussion of Genus-Species anticipation. With respect to Claim 9, Gase teaches the pipe server thread(part) connection between elements 28' and 28 on the front page diagram. With respect to Claim 10, Gase teaches the updating step in figure 3a. With respect to Claim 11, Gase teaches transferring step in Abstract, lines 9-16. With respect to Claim 14, Gase teaches the data is printer status data in figure 3b. With respect to Claims 16 and 19, it is noted that the print server registry is transferred to

the first and second clients as taught by Gase in figures 4 and 3a. The Examiner considers this to be "regular" or periodic as broadly recited in Claim 16. With respect to Claim 17, Gase teaches the polling function in figure 3a. With respect to Claim 18, note the rejections of Claims 8-9 hereinabove. With respect to Claim 22, Gase teaches the driver 28' on the front page diagram.

5. Claims 1-2,4-6,7,11-12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by White et al (US 6,301,012 B1, hereinafter "White").

With respect to Claims 1 and 7, White teaches gathering step in figure 2, element 130, the monitoring step in figure 2, element 135, the recognizing step in figure 2, element 190 and the saving/updating step in figure 2, element 195. With respect to Claim 2, White teaches the waking and alerting steps in figure 3, elements 150,160,175,180 and 185. With respect to Claim 4, White teaches the polling step when a new printer is installed in figure 2, element 135 and the comparing step in figure 2, element 190. With respect to Claim 5, it is noted that White teaches that comparison is made with the new printer configuration data does not match the stored configuration data in figure 2 element 135 or 190. Further, White teaches that the printer driver is awakened in figure 3, element 160. It is noted that an unavoidably necessary part of White's invention is the setting of flags to perform the procedure as outlined in figures 2 and 3. Further, it is noted that flags are simply indicators in a program to initiate some activity. The comparisons of White as illustrated in figures 2 and 3 are certainly flags(indicators) which prompt an activity of printer driver comparison and updating to the printer spooler. With respect to Claim 6, White teaches the use of the Windows Operating system to

send the print driver information in column 2, lines 52-58 and figure 3 element 150. It is noted that the application program interface in figure 3 is the network program containing the drivers needed to operate the printer in that embodiment of White. With respect to Claim 11, White teaches the server thread(part) that determines the configuration options from the server registry(cache) and transfers the configuration options to the client device(spooler) in figures 2 and 3. With respect to Claim 12, White teaches the transfer of configuration options using a Windows based operating system object in figure 2-3 and column 2, lines 53-57 and column 3, lines 60-65.

Allowable Subject Matter

6. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

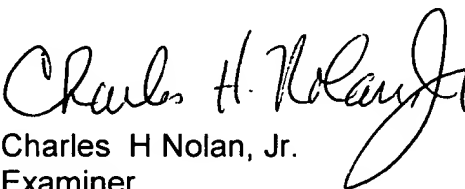
7. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 703-308-0961. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-308-5841 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.


Charles H Nolan, Jr.
Examiner
Art Unit 2854

CHN
February 28, 2002